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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,789	07/10/2000	Satyan G. Pitroda	2683/79382	9381
24628	7590	05/18/2007	EXAMINER TRINH, TAN H	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			ART UNIT 2618	PAPER NUMBER PAPER
MAIL DATE 05/18/2007		DELIVERY MODE		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/612,789	PITRODA, SATYAN G.	
	<b>Examiner</b>	<b>Art Unit</b>	
	TAN TRINH	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 18 October 2006.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-19 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    Paper No(s)/Mail Date. \_\_\_\_\_  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_                    5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-4, 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaillard (U.S. Pub. No. 20030028458) in view of Stoutenburg (U.S. Pub. No. 20030222135)

Regarding to claim 1, Gaillard teaches a method of exchanging payment information in an electronic transaction, comprising:

a) a first electronic transaction device transferring payment information to a second electronic transaction device (See figs. 1 and 3, first electronic transaction device's item 28 (PPITCD (smart card) 28) and second electronic transaction device's item 12 (debit machine 12) and page 2, session [0019-0020]).

b) the second electronic transaction device transferring value information to the first electronic transaction device (See figs. 1 and 3, second electronic transaction device's item 12 transferring value information (see fig. 1, amount payable = 236.75 US\$) to first electronic transaction device's item 28, and page 2, session [0021-0022]).

c) the second electronic transaction device transferring value information and payment information to a service consolidation center (see figs. 1 and 3, second electronic transaction device's item 12 and information to a service consolidation center item 18 (Financial Institution), and page 2, session [0026]). And (See page 8, sessions [0237-0247]).

Still regarding claim 1, Gaillard fails to teach a newly added a virtual card. Such teaching is taught by Stoutenburg (see page 12, sections [0131-0132] on the issuance of physical stored value card or a virtual stored value card such Virtual card).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Gaillard with Stoutenburg, in order to provide user with the virtual card via email or the virtual card to a merchant to consummate a particular transaction (see Stoutenburg page 12, section [0132]).

Regarding to claim 3, Stoutenburg teaches the value information comprises a virtual card authorization code (see page 12, section [0130-0131] with Unique Identify and a PIN code).

Regarding to claim 4, Stoutenburg teaches wherein the virtual card comprises an image of a card (see fig. 10 document Imager, for merchants to process multiple types of electronic-payment and other transactions, and issuance of coupons on the document Imager and display virtual store value such virtual card, that is comprises an image of a card, page 3, section [0040] and page 12, section [0131-0132]).

Regarding to claim 8, Gaillard teaches the payment information comprises credit payment information (see page 1, session [0005]).

Regarding to claim 18, Stoutenburg teaches wherein the virtual card comprising a digital representation of information corresponding to information stored on a physical card (see page

12, section [0131-0132] since the physical card or virtual card to a merchant to consummate a particular transaction. So that the virtual card comprising a digital representation of information corresponding to information stored on a physical card.

3. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaillard (U.S. Pub. No. 20030028458) in view of Stoutenburg (U.S. Pub. No. 20030222135) further in view of Resnick (U.S. Pub. No. 20010001321).

Regarding claim 5, Gaillard teaches the value information (see figs. 1 and 3). But Gaillard or Stoutenburg fails to teach a quantity of minutes corresponding to pre-paid telephone account.

However, Resnick teaches a quantity of minutes corresponding to pre-paid telephone account (see page 1, session [0004], lines 1-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Gaillard and Stoutenburg and by the teaching of Resnick on pre-paid telephone account thereto in order to provide user with the convenience for prepaid wireless service.

Regarding to claim 6, Gaillard teaches the payment information (see fig. 1). But Gaillard or Stoutenburg fails to teach the cash payment information.

However, Resnick teaches the cash payment information (see fig. 2, page 1, session [0003] and session [0006]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Gaillard and Stoutenburg and by the teaching of Resnick on cash payment thereto in order to provide the convenience for user with cash payments at a multitude of merchant locations.

Regarding to claim 7, the cash payment information includes an identification of a person is providing a cash payment. That is obvious to create a trace of their subscriber and created a profile for each subscriber whether they use cash or credit card.

4. Claims 9 -11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoutenburg (U.S. Pub. No. 20030222135) in view of Johnson (U. S. Patent No. 6535726).

Regarding to claim 9, Stoutenburg teaches the method of tracking retail sales of pre-paid cards to cash subscribers (see page 13, section [0135]) comprising

a); an entering value purchased information and subscriber information in a retailer electronic transaction device (see page 14, sections [0146-0148] see enter the value into POS device 130 via keypad, the value can be added and a mount is to be added to existing phone card and card information)

b) the retailer electronic transaction device transferring the value purchased information and subscriber information to a network (see page 14, sections [0147-0149])

c) the customer can adding value corresponding to the value purchased information to an account corresponding to the subscriber information (see page 14, sections [0150-0151]). But

Stoutenburg fails to teach the transferring the value to mobile phone operator or mobile phone operator can added the value of the purchase information.

However, Johnson teaches transferring the value purchased information and subscriber information from a MO subscriber handset to the retailer electronic transaction device (see fig. 1A, Mobile phone 140, transferring information from a MO subscriber handset 140 to the retailer electronic transaction device (POS) 110, col. 4, lines 24-col. 5, line 2, and col. 7, lines 3-lines 42). And MO subscriber handset can transfer information to POS (see fig. 1A, mobile 140 send information to POS 110)

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Stoutenburg with Johnson, in order to provide user using the mobile phone to pay purchased good in point of sale POS.

Regarding to claim 10, Stoutenburg teaches the step of entering value purchased information and subscriber information in a retailer electronic transaction device (see page 14, sections [0146-0148]). But Stoutenburg fails to teach transferring the value purchased information and subscriber information from a MO subscriber handset to the retailer electronic transaction device.

However, Johnson teaches transferring the value purchased information and subscriber information from a MO subscriber handset to the retailer electronic transaction device (see fig. 1A, Mobile phone 140, transferring information from a MO subscriber handset 140 to the retailer electronic transaction device (POS) 110, col. 4, lines 24-col. 5, line 2, and col. 7, lines 3-lines 42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Stoutenburg with Johnson, in order to provide user using the mobile phone to pay purchased good in point of sale POS.

Regarding to claim 11, Stoutenburg teaches manually entering the value purchased information and subscriber information into the retailer electronic transaction device (see page 14, sections [0146-0148] see manually entering the value into POS device 130 via keypad.

5. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Despres (U.S. Patent No. 6434379) in view of Pitroda (U.S. Patent No. 6769607).

Regarding to claim 12, Despres teaches a method of distributing virtual pre-paid cards (see fig. 1 and 3, col. 1, lines 28-40) comprising: a) creating virtual prepaid card (see fig. 1 and 3, col. 1, lines 28-40 and col. 2, lines 25-43), b) downloading the virtual pre-paid card to the retail electronic transaction device (DECT, PHS network) (see col. 2, lines 50-col. 3, line 3, and col. 4, lines 49-52), c) and transferring virtual pre-paid card from the retail electronic transaction device (DECT, PHS network) to MO subscriber handset (see fig. 1, mobile phone 16 and 17, col. 4, lines 38-col. 6, lines 67), Despres teaches transferring virtual pre-paid card from (DECT, PHS) network (see fig. 1). But Despres fails to teach transferring virtual pre-paid card from the electronic transaction device.

However, Pitroda teaches transferring virtual pre-paid card from the electronic transaction device (see fig. 3, 5 and fig. 7, electronic transaction device 60 for transferring virtual pre-paid card from mobile phone, col. 3, lines 52-col. 4, lines 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Despres with Pitroda in order to provide user with the virtual pre-paid card for using on the mobile phone.

Regarding to claim 13, Pitroda teaches the step of transferring payment information from the MO subscriber handset to the retailer electronic transaction device (see fig. 3-5).

Regarding to claim 14, Despres teaches the step of creating a virtual card is performed by an electronic transaction device service center (see fig. 1 and 3, col. 1, lines 28-40 and col. 2, lines 25-43).

Regarding to claim 15, Pitroda teaches transferring payment information and subscriber information from the MO subscriber handset to the retailer electronic transaction device (see fig. 3, mobile phone and PDA to retailer electronic transaction device and POS); transferring the payment information and subscriber information from the retailer electronic transaction device to the electronic transaction device service center (see fig. 3, POS to merchant mainframe and transaction network).

Regarding to claim 16, Despres teaches downloading the virtual card to a retailer electronic transaction device occurs via a MO switch (see fig. 1, col. 4, lines 38-48).

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6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Despres (U.S. Patent No. 6434379) in view of Pitroda (U.S. Patent No. 6769607) further in view of Tushie (U.S. Patent No. 6,202,155).

Regarding to claim 17, Despres or Pitroda fails to teach the step of downloading batches of virtual transaction cards to the retailer electronic transaction device.

However, Tushie teaches the step of creating a virtual card comprises creating a plurality of virtual cards and the step of downloading the virtual card to a retailer electronic transaction device comprises downloading batches of virtual transaction cards to the retailer electronic transaction device (see figs. 1-2 and 6A-B, col. 1, lines 29-40, col. 2 lines 51-67 and col. 3 lines 1-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above combination of Despres and Pitroda with Tushie on the downloading batches of virtual transaction cards technique thereto in order provide the issuer to identify the easier.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gaillard (U.S. Pub. No. 20030028458) in view of Stoutenburg (U.S. Pub. No. 20030222135) further in view of Hertzog (U.S. Pub. No. 20030069874).

Regarding to claim 19, Gaillard or Stoutenburg fails to teach wherein the virtual card comprising logo and branding information. Such teaching is taught by Hertzog (see figs. 9A-C, with picture, company, name and logo on the virtual card).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above combination of teaching of Gaillard and Stoutenburg with Hertzog, in order to provide user with display logo or name in virtual card.

***Response to Arguments***

8. Applicant's arguments filed 10-18-2006 have been fully considered but they are not persuasive.

Applicant argues that the filing date of the reference Stoutenburg (U.S. Pub. No. 2003/0222135) is April 3, 2002, and related U.S. Applicant data that is continuation in part of applicant No. 09/634,901 Now Patent No. 6,547,132 is the filed data is August 9, 2000, the filling data of this applicant is after the filling data of the present applicant. However, the examiner does not used the filing data listed above, the filling date for using to against the present applicant is the Provisional application No. 60/147,899, filed on August 9, 1999. This is entitled and prior to the present of the applicant date. Provisional application No. 60/147,899 also related and supported the reference Stoutenburg (U.S. Pub. No. 2003/0222135), for the integrated point of sale POS, transaction using the credit, debit and smartcard. (See Provisional application No. 60/147,899 integrated point of sale device pages 1-2, smartcard on pages 29-35).

Applicant also argues that the filing date of the reference Gaillard (U.S. Pub. NO. 2003/0028458) using the Provisional application No. 60/214,436, filed date is June 28, 2000 is not before the date of present applicant. Applicant state the Declaration of Satyan G. Pitroda for the application is June 20, 2000 the is not in the record. The Declaration of Satyan G. Pitroda is

submitted on 7-10-2000 is no inventor or join inventor's signature, the Declaration of Satyan G. Pitroda is resubmitted on 11-22-2000 are showed the filed date is July 10, 2000 (07-10-200).

Therefore, the Provisional application No. 60/214,436, filed date is June 28, 2000 is prior to the present of the applicant date.

Regarding claim 12, Applicant argues the Despres reference (U.S. Patent No. 643479) does not teach the transferring virtual pre-paid card from the electronic transaction device. However, the second reference of Pitroda teaches the transferring virtual pre-paid card from the electronic transaction device (see fig. 3, 5 and fig. 7, electronic transaction device 60 for transferring virtual pre-paid card from mobile phone, col. 3, lines 52-col. 4, lines 18). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the signal received from PDA, mobile phone, wireless phone or handheld devices can be converted to conventional magnetic strip and/or smartcard format, that is transferring virtual pre-paid card with the electronic transaction device 60 to the POS card reader and reading the converted information data of the buying and payment electronic transaction format, that is obvious to the transferring virtual pre-paid card from the electronic transaction device. Therefore, the combination of Despres and Pitroda is teaching the limitation of the claim invention.

Regarding claim 17, Applicant argues the Tushie reference (U.S. Patent No. 6,202,155) does not teach to teach the transferring virtual pre-paid card to retailer electronic transaction device. However, the combination of Despres and Pitroda is teaching the transferring virtual pre-paid card to retailer electronic transaction device (see rejection and on claim 12 and responding to argument regarding claim 12 above).

Applicant also argues the Tushie reference teaches the “physical transaction card” and is not a “virtual card”. However, the examiner does not agree. Since Tushie reference is teaches the step of creating a virtual card, and downloading batches of virtual transaction cards to the retailer electronic transaction device (see figs. 1-2 and 6A-B, created virtual card object on fig. 6A step 603 and send the message to make card, and received virtual card object on step 607 and col. 2 lines 51-67 and col. 3 lines 1-23). In this case, a virtual card personal system uses a plurality of virtual device that is virtual card using in electronic virtual transaction device (see A “virtual card” on col. 2, lines 51-62. Therefore, a “virtual card” of Tushie reference is read on the limitation of the claim.

Regarding claim 19, the filing date of the reference Stoutenburg (U.S. Pub. No.2003/0222135) and Gaillard (U.S. Pub. NO. 2003/0028458). see the Response to Arguments for this filing date above.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(571) 273-8300, (for Technology Center 2600 only)**

*Hand-delivered responses should be brought to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (571) 272-7888. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Anderson, Matthew D., can be reached at (571) 272-4177.

The fax phone number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tan H. Trinh  
Division 2618  
May 3, 2007

Anderson, Matthew D. (SPE 2618)

